

Appl. No. 10/706,065
Amendment G Dated October 14, 2008
Reply to Office Action of July 14, 2008

Docket No. 27600/X014A

REMARKS

Claims 1-68 are pending and at issue in the present application. Claims 1-55 stand rejected as obvious over varying combinations of Dooley U.S. Patent No. 6,257,566, Graushar U.S. Patent No. 5,100,116, or Weller U.S. Patent No. 4,989,850 and Warmus *et al.* U.S. Patent Nos. 6,327,599 and 5,963,968. The examiner is requested to hold the claims 56-68 in abeyance pending the filing of one or more divisional applications. Applicants respectfully traverse all of the pending rejections of claims 1-55.

With respect to the rejections of claims 1-55, applicants respectfully reiterate the arguments presented in the Office action Response F filed on June 16, 2008. To summarize, Dooley and Graushar teach the use of conventional bindery line controllers and Weller is silent regarding a controller. In particular, Dooley teaches "[a] controller 26, which is preferably a programmable logic controller or a similar controller of the type commonly employed in printing operations, controls the operation of the binding line 12." (Dooley, col. 3, line 65 to col. 4, line 1.) Similarly, Graushar discloses that "[t]he collating and binding system generally described above is conventionally controlled by a conventional computer or programmable controller 31, the details of which are omitted as they do not form the essence of the invention." (Graushar, col. 4, lines 36-40.)

As argued in the remarks of the Response F and the declaration of Mr. Michael Sittinger under 37 C.F.R. § 1.132, filed on January 16, 2008, each of the ink jet heads disclosed in the cited art inherently includes a speed tracking device that receives timing information from a binding line to enable the ink jet head to synchronize the printing speed thereof with the speed of the binding line. . . The speed of each of the ink jet heads is synchronized to the speed of the binding line (i.e., the gathering chain) using such timing information. In contrast, the amount of time necessary for the demand print system (i.e., the variable print engine, the RIP, the demand printer, etc) to generate a particular signature varies in accordance with the complexity of the pages that comprise the signature even if the speed of the demand printer is constant. Therefore, to ensure that a signature of a book may be available at the gathering line when such signature is required, "the controller 100 orders a variable signature earlier in the production sequence so that the signature can be produced in time to meet the other book components at the proper place on the gathering line." (Page 9, lines

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6-7 of the specification). Such additional control functions are not disclosed by the cited art, and are not available in the conventional controllers disclosed thereby. Therefore, the applicants respectfully submit that none of the prior art cited by the examiner, either alone or in combination, teaches or suggests a controller that controls the operation of a gathering line, feeding device, and a demand printer as recited by claims 1-35, 43-48, and 55. The applicants further submit that none of the prior art cited by the examiner teaches or suggests a step of coordinating simultaneous operation of a gathering line, a demand printer, and a feeding device during a production sequence to produce books as recited by claims 36-42 and 49-54.

The Supreme Court has held that the teaching, suggestion, motivation ("TSM") test should not be strictly applied. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct 1727, 1741 (2007). However, the Court also noted that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* Instead, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *Id.* The examiner has not stated any reasons why a person of ordinary skill in the art would have been prompted to combine any of the cited art to arrive at the subject matter recited by the claims at issue.

Further, to support a *prima facie* case of obviousness based on a combination of prior art elements, an examiner must establish "a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference." Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* 72 Fed. Reg. 57,526 (Oct. 10, 2007). The cited art, alone or in combination, does not disclose or suggest each of the elements recited by the claims at issue.

Furthermore, at least a reasonable expectation of success in combining prior art references is required to render an invention obvious. *In re Merck & Co.*, 800 F.2d 1091, 1096 (Fed. Cir.1986). There is no suggestion that a person of ordinary skill in the art could have successfully combined any of Graushar, Dooley, or Weller with Warmus *et al.* '599 or '968 to arrive at the subject matter recited by claims at issue. Specifically, a combination of a well known controller with the demand

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printers of the Warmus *et. al.* '599 or '968 as suggested in the Office action would not result in a book production apparatus as recited by the claims at issue. Rather, such combination would result in an inoperable device or a device that would be unable to coordinate the operation of the gathering line, one or more demand printer(s), and the feeding device to produce books.

Therefore, it follows that the claimed subject matter is not rendered obvious by the cited art. For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested. An early and favorable action on the merits is respectfully requested.

Deposit Account Authorization

The Commissioner is hereby authorized to charge any deficiency in any amount enclosed or any additional fees which may be required during the pendency of this application under 37 CFR 1.16 or 1.17, except issue fees, to Deposit Account No. 50-1903.

Respectfully submitted,

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